

REMARKS

Claims 1-5 and 8-17 are pending in the present application. Claims 1 and 2 have been amended. The claims have been amended to more particularly point out that which applicants regard as the invention. No issue of new matter is raised by these changes. Accordingly, upon entry of this Amendment, claims 1-5 and 8-17 will still be pending and under examination.

35 U.S.C. §102

The Examiner maintained the rejection of claims 1, 5, 8, 10-12, 14 and 15 under 35 U.S.C. §102(b) as allegedly anticipated by Buckett.

According to the Examiner, Buckett discloses esters of 14-hydroxycodeinone having analgesic activity. The two compounds disclosed in table 2 on page 70T (where R represents –COCH=CH-Ph or –COCH=CH-CH₃) allegedly anticipate the instant claims when R₂ represents either C₃-C₆ alkenoyl or C₉-C₁₆-arylalkenoyl in the instant compounds of formula (I).

In response, and without conceding the correctness of the Examiner's rejection, applicants note that claim 1, as amended, does not recite C₃-C₆-alkenoyl or C₉-C₁₆-arylalkenoyl as a substituent of R₂. Accordingly, applicants maintain that the claimed subject matter is novel.

35 U.S.C. §112, First Paragraph

The Examiner rejected claims 1-5 and 8-17 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that the amendment to the claims to introduce "new" values for substituent R₂ constitutes the addition of new matter, since such values allegedly were not present in the original specification.

In response, applicants respectfully traverse the Examiner's rejection.

Applicants stress that the amendments to the claims (e.g. to claims 1 and 2) introduce no “new” values to the various substituents. By way of example, in the previous amendment, for substituent R₂, applicants deleted the moiety “C₇-C₁₆-arylalkyl” and replaced it with “C₈, C₉, C₁₀, C₁₁, C₁₂, C₁₃, C₁₄, C₁₅, or C₁₆-arylalkyl.” It is important to note that the original language “C₇-C₁₆-arylalkyl” has the identical meaning and is thus interchangeable with, “C₇, C₈, C₉...C₁₆-arylalkyl.” In other words, the recitation of a carbon atom range such as “C₇-C₁₆” is simply shorthand for the individual recitation of each of the ten members of that group (namely C₇, C₈...C₁₆). It follows that each of the ten members of the group “C₇-C₁₆-arylalkyl” was explicitly included in claim 1 as an embodiment of R₂. Thus, canceling one of these ten members, i.e. “C₇-arylalkyl”, while leaving members C₈-C₁₆-arylalkyl in the claim, has explicit support, since each of members C₈-C₁₆-arylalkyl is explicitly supported. Thus, applicants’ amending the claims to change “C₇-C₁₆-arylalkyl” to “C₈, C₉...C₁₆-arylalkyl” does not constitute the addition of new matter.

In view of the above, applicants respectfully maintain that the claims satisfy the written description requirement under 35 U.S.C. §112, first paragraph.

35 U.S.C. §112, Second Paragraph

The Examiner also rejected claims 1-5 and 8-17 under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Specifically, the Examiner asserts that certain embodiments of R₂ are confusing or without antecedent basis.

First, the Examiner asserts that for claims 1-3, in the substituent R₂, the amended C₈-C₁₆-arylalkanyl and -arylalkenoyl moieties are indefinite and confusing, since when aryl is C₆ and either alkyl is C₁ or alkenyl is C₃, an “excluded” C₇-arylalkyl group or C₉-arylalkenyl group will be represented.

In response, applicants respectfully traverse. The claims as amended clearly define R₂ as including C₈ to C₁₆-arylalkyl or arylalkenoyl moieties. The aryl portion is clearly defined as being C₆ to C₁₀-aryl, and the alkyl is defined as being C₁ to C₆-alkyl. Thus, to obtain a C₈-arylalkyl substituent for aryl being a C₆ moiety, for example, the alkyl substituent must be chosen as being C₂. Further, in the case where aryl is C₆, alkyl cannot be C₁. However, when a naphthyl moiety is used as the aryl group (C₁₀-aryl), the alkyl group may be chosen as being C₁ (see claim 5). The same reasoning applies for arylalkenoyl substituents. Therefore, the definition of R₂ is neither indefinite nor confusing.

Second, the Examiner notes that the limitation "benzyl" is recited for substituent R₂ in several compounds recited in claim 5, without antecedent basis.

In response, applicants note that claims 1 and 2 have been amended to recite benzyl as an embodiment of substituent R₂.

If any additional fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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